

REMARKS

In regard to the Examiner's Office Action of August 12, 2004, Applicants are herein presenting their considerations on the subject matter involved.

Per Examiner's request for restriction as to claim set I, or claim set II, Applicants have now cancelled claim 1 of claim set I and selected claims 2-10 of the claim set II. Thus, Applicants have selected claim set II which includes original claims 2-10 and new claim 11 as the subject matter of prosecution for this application. In regard to the section of "CROSS-REFERENCE TO RELATED APPLICATIONS", Applicants have now supplied the missing application numbers of the co-pending applications cited.

In regard to the Information Disclosure Statement request, Applicants will be providing copies of any patents and publications which are related to the claimed invention, together with a concise statement of explanation of that publication's contribution to the description of the prior art, attached as Appendix I.

In regard to Examiner's claim rejections under 35 USC 112, where Examiner feels there is no software or hardware to implement a method for developing data as to specific user weight categories for each user-type involved with each specific application, the specific examples and specifications given on page 26 of the specification, in addition to the specific examples shown on pages 22, 23, 24 and 25 gives specific examples for utilization of heavy, medium, light, and super-heavy operations. In regard to implementing a method for developing data as to the specific user weight categories for each user type

involved with each specific application, it should be noted that a customer profile of this information regarding a customer's requirements was disclosed in the co-pending application, Docket 041-509-L (USSN 09/813,667) entitled "Thin Client Sizing Tool For Enterprise Server Farm Solution Configurator", and also in co-pending application, Docket 041-510-L (USSN 09/813,671) entitled "Configuration Interview Session Method For Thin Client Sizing Tool", where there was developed a customer profile which could be stored in a database.

These should be understood to be related to Figs. 1, 2A, 2B, and 2C, to illustrate how these factors are involved to provide input to the Solution Configurator which was described in USSN 09/813,667.

The Examiner has rejected claims 2-10, under 35 USC 103(a) as unpatentable over the Freeman reference, U.S. Patent 2002/000613A1.

In this regard, Applicants must herein traverse Examiner's consideration as to the relevance of the Freeman reference.

Here, it should first be noted that Freeman does not teach a Thin Client Sizing Tool for configuration of an Optimal Server Farm for a customer enterprise -- Freeman involves the problem of a method and apparatus for communication between servers, which servers have a second plurality of subsystems. The communication is done by transmitting an "Event" to a first transport mechanism based on an entry in a first dispatch table.

Freeman relates to a multi-server system, including a first server and a second server. The first server has a first plurality of sub-systems and a first Event bus associated with a

first plurality of sub-systems. The first Event bus includes a first Event delivery object having a first dispatch table and a first transport mechanism associated with a first Event delivery object.

The second server has a second plurality of sub-systems, where one of the first plurality of subsystems communicates with one of the second plurality of subsystems by transmitting an Event to the first transport mechanism based on an entry in a first dispatch table.

Here in Freeman, an administrator will provide a user with access to a number of application servers that host the desired applications and are capable of serving the user's requests.

However, in order for such a system to operate efficiently, the application servers must dynamically coordinate access to system resources shared among the application servers, as well as coordinate access to the application servers by the user.

One way this is done is to select one server from the group to act as a "master server". The master server is responsible for keeping track of resource usage both by users and application servers.

Here, it may be observed that the Freeman patent has to do with the interconnection of multiple Server Farms and the control of their usage --- it has nothing to do with solving the problem of designing and configuring an optimal Server Farm.

The Examiner has cited pages 1 and 2 of Freeman, and also pages 30-33, wherein page 3 of Freeman lists a catalog of titles going from 7.9 (Application and Server Systems) over to 8.0 (Administration Tool) which supposedly applies to the material on pages 30-35.

To summarize Freeman pages 31-35, we see at paragraph 0472, there is discussed a common server sub-system; then at paragraph 0477 there is discussed a specialized server sub-subsystem, which as stated in paragraph 0486 is used to manage information regarding disconnected sessions.

Then Freeman paragraph 0492 describes application name resolution, where, in order to execute an application, the server 180 must first resolve the application name. Then, Freeman paragraph 0501 involves "Application Enumeration". This enables a user of the client 120 to view the names of every published application. Then Freeman paragraph 0151 involves an "administration sub-system", where each server 180 in the Server Farm 110 includes an administration sub-system 300 . . . that enables other sub-systems 300 to publish their data to the administration tool 140 on the client 120.

Paragraph 0512 of Freeman describes an administration tool to provide a graphical interface that defines and manages menus, toolbars and data associated with sub-systems 300 on the servers 180 of the Server Farm 110.

Then at Freeman paragraph 0518, a discussion is had for administering the licensing sub-system, where the

administration tool 140 displays licensing information in two panels -- a left panel and a right panel.

The question arises regarding Freeman is --- what problem is the Freeman reference trying to solve? Apparently, the only thing here is that Freeman is developing a communication system among a network of servers.

This does not teach or provide for the utilization of sizing information which can be used for the design and development of an optimal Server Farm configuration tailored to a specific client-customer's requirements.

The stated generalities in Freeman regarding the various intercommunication systems for multiple groups of servers do not meet the teaching of Applicants' system on a "method for calculating user weights for a Thin Client Sizing Tool".

APPLICANTS' CLAIM 2(a): The Examiner cites the Freeman column 1, paragraphs 5-12, as teaching Applicants' element --- selecting each application in said Server Farm which processes 16-bit or MS-DOS programs.

Here, it should be readily seen that none of these Freeman paragraphs have anything to do with selecting an application in a server which processes 16-bit or MS-DOS programs.

IN APPLICANTS' CLAIM 2(b): Examiner has not cited any teaching in the references as to --- accumulating the number of user-type users for each application categorized as super-heavy users of that application.

IN APPLICANTS' CLAIM 2(b): Examiner has cited Freeman column 3, paragraphs 84-96: It should be noted that what Examiner has cited here is merely a list of titles of various contents in the Freeman application, and there are no specific operational text or teachings which involves this material.

IN APPLICANTS' CLAIM 2(d): Examiner has cited Freeman column 3, paragraphs 84-96. Here again, these are merely a Table of Contents and there is no specific text or description which goes with them.

IN APPLICANTS' CLAIM 2(e): Examiner has cited Freeman column 3, paragraphs 49-96.

Note here, that this is merely a list of titles in a Table of Contents, and there is no text or teaching which is provided.

Likewise, with Applicants' claim 3, clauses (a), (b) and (d), the Examiner has cited Freeman on a mere Table of Contents with titles, with no back-up or teaching whatsoever, and further clause (c) of Applicants' claim 3, is not taught anywhere according to Examiner's statement.

IN APPLICANTS' CLAIM 4 (a), (b), (c) AND (f): Here again, Examiner has cited merely a set of titles in a Table of Contents of Freeman, with no back-up text whatsoever or teaching involved.

Further, in Applicants' claim 4, clauses (d) and (e) are not even mentioned as having been suggested in some reference or another.

IN APPLICANTS' CLAIM 5(c), (d), (e), (f), (g) and (h): Again, we can see that there is no teaching in the Freeman reference, but only a mere statement by Examiner which lists a series of titles at column 3 of the Freeman reference.

IN APPLICANTS' CLAIMS 6, 7 8 and 9: Examiner has merely cited certain titles listed in column 3 of Freeman, plus Examiner's statement regarding Official Notice that these concepts are well-known and expected in the art.

This is the very point here -- that these concepts are NOT well known and expected in the art, and that is the reason they have been used here in order to develop input to a solution configurator at step D13 of the sequence shown in USSN 009/813,667. (Amended claims).

It should further be noted that the claims just discussed have all been amended in order to more specifically describe the operations that are taking place and how these claims provide an input to the Solution Configurator at step D13 of USSN 09/813,667.

The Examiner has further rejected claims 2-10 under 35 USC 103(a) as unpatentable over Logston, U.S. Patent 6,687,735, in view of Examiner's statement of "Official Notice". In the case of In re Lee, 61 USPQ2d, p.1430 (Fed.Cir.2002) the case of In re Lee, stands for the proposition that there is no validity to the so-called doctrine of "official notice or statements regarding common knowledge of one of ordinary skill in the art".

This case had been appealed to the Federal Circuit, where speaking for the Court, Judge Newman held that the "motivation to combine

requirement" could not be resolved when subjective belief and unknown authority was involved. The Court further held that the Board's conclusion that they (Board) could find obviousness without "any hint or suggestion in a particular reference" was an omission of a relevant factor . . . and therefore, it was to be considered legal error and arbitrary agency action. 61 USPQ2d p.1434. Thus, the case of In re Lee, strikes down the use of "Official Notice" or "common knowledge of one skilled in the art" as applied by an Examiner when the Examiner makes an obviousness determination.

The first thing that must be mentioned is that Logston does not teach a thin client sizing tool for configuring an optimal Server Farm for a customer enterprise --- Logston involves an improved method and apparatus for balancing distributed applications within a client server network, such as a cable television network.

The Logston reference relates to the field of software applications that are distributed over an information network -- and specifically to the dynamic distribution and division of software applications and other associated components between the client devices and the servers on the network.

In summary, Logston says he provides an improved method of starting and downloading the client portion of a distributed application on a client server. The method comprises the steps of providing a distributed application having a plurality of separable modules; disposing the distributed application on a server within a

network; transferring a first portion of the plurality of modules to a client device via a first communication channel; attempting to establish a second "reverse" communication channel between the client device and the server; detecting when the reverse channel has not been established, and subsequently transferring additional modules of the distributed application to the client device from said server in a pre-determined increment until the second communication channel can be successfully established.

In summary, Logston provides a method and apparatus for automatically and dynamically distributing the load of the server portion of distributed applications among multiple threads on a designated server machine and/or among multiple server machines. A Distributed Application (DA) within the context of Logston, is defined as a computer program that is broken into multiple components.

This type of development by Logston is certainly not the focus of Applicants' system. Applicants' system is a thin client sizing tool for the purpose of collecting information so as to enable the configuration of an optimal Server Farm or Farms suitable for matching special customer enterprise needs.

It would be obvious here to see that there is no correlation between the Logston teaching and the teaching of Applicants' system and methodology.

In Applicants' claim 2(a), Examiner cites the Logston column 2, line 50 through column 4, line 54: -- as teaching Applicants' clause (a) of selecting each application in said Server Farm which processes 16-bit or MS-DOS programs.

There is nothing in the Logston columns 2 through columns 4, which indicate the teaching of Applicants' claim 2(a). All that Logston does here is give various aspects of his invention, none of which involves the selecting of applications in the Server Farm.

IN APPLICANTS' CLAIM 2(c): Examiner cites Logston column 2, line 50 through column 4 line 54, on the basis that it teaches to check whether more applications are involved in a series of steps which is indicated by Applicants here as steps (a), (b), (c), (d), (e).

There is no such teaching in Logston which involves accumulating the number of user-type users for each application categorized as super-heavy users of that application, nor is there any teaching for totaling the number of user-type users who are super-heavy users, nor is there any teaching by Logston of the Applicants' amended claims here which involve certain weighted percentage values which are used for later input

to a Solution Configurator which inputs to step D13 of USSN 09/813,667 (Docket 041-509-L).

All that Examiner has indicated in the Logston references is a series of very generalized statements regarding servers and communication between servers, and here we must ask the question:

How exactly would the Examiner apply the Logston reference to develop an optimal Server Farm via a solution configurator?

Likewise, the same question would be applied to the cited Freeman reference --- *How would Examiner use the teaching of the Freeman reference in order to develop optimized Server Farms to satisfy the requirements of a customer's enterprise?*

In regard to the Examiner's considerations about "Official Notice" regarding the concept and advantages of ---- selecting applications having a 16-bit or MS-DOS program or --- not 16-bit or MS-DOS program or --- having processing background or --- graphic-based or animated graphic-based or animated background or --- input mostly GUI-based/background processing light, or --- output mostly text-based, and the categories of being light and heavy ---- which Examiner says is "well-known and expected in the art" --- Applicants' would contravene such a conclusion on the part of the Examiner, especially since as seen in the amended claims, there is developed a specialized set of "percentage weights" which is given to the different categories in order to influence the input to the solution configurator of step D13 of USSN 09/813,667.

And further, as indicated in In re Lee, such Official Notice is not warranted.

Regarding Applicants' claims 6-10 amended, it should now be noted that Logston cannot teach and cannot be seen to teach, according to any of the cited paragraphs and references cited by Examiner, the various steps involved and applicable to the input to the Solution Configurator of USSN 09/813,667.

The Examiner has further rejected the claims 2-10 under 35 USC 102(e), as anticipated by the Smorodinsky U.S. Patent 6,496,948, plus the Smorodinsky U.S. Patent 6,571,283, in addition to the Mackey U.S. Patent 6,567,767, and another Mackey U.S. Patent 6,691,259.

At this point, the Applicants would indicate that it is not proper and suitable to reject Applicants' claims on the basis of commonly owned prior patents, as will be seen the Manual of Patent Operating Procedure at MPEP 706.02(1).

It will be seen that it is not permissible to reject a patent application on the basis of prior patents which are commonly owned by the same entity. As stated in the MPEP Section 706.02(1), at notation (4), ---- subject matter which is developed by another person which qualifies as prior art only under 35 USC 102(f) or (g) may be used as prior art under 35 USC 103 against a claimed invention unless the entire rights to the subject matter and the claimed invention were commonly owned by the same personal organization or subject to an obligation of assignment to the same person or organization at the time the claimed invention was made.

Here, it should be noted, that the common ownership to Unisys Corporation of the Smorodinsky patent 6,496,948 (Docket 041-475-L) was recorded at Reel/Frame 010403/0726, while the first Mackey patent 6,567,767, (Docket 041-505-L) is shown at Reel/Frame 011223/0308 and the second Mackey patent 6,691,259, (Docket 041-506-L) is shown at Reel/Frame 011223/0301.

It is now requested that Examiner withdraw his use of these references to Smorodinsky and to Mackey as references against the subject patent application.

In view of the uniqueness of the usage of user weights which are to be calculated according to the prescribed processes of this application, and then which are to be input to the general overall sequence of the Solution Configurator in USSN 09/813,667, it should readily be seen that there is provided a unique sequence of steps which provide for a thin client sizing tool whereby there can be developed the optimum group of Server Farms to suit a customer's enterprise.

In this regard, Examiner is exhorted to follow the normal rule of the patent law which states that the invention should be looked at as a whole in its entirety. So, in this

regard, Applicants would now pray that a timely Notice of Allowance be forthcoming.

Respectfully submitted,

By Alfred W. Kozak
Alfred W. Kozak
Reg. No. 24,265
(858) 451-4615

Certificate of Mailing (37 CFR 1.8a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date:

November 10, 2004

Patti S. Greddy

Patti S. Greddy

APPENDIX I
(DOCKET 041-513-L)

Per the Examiner's request for copies of any patents and publications related to the claimed invention, Applicants are herein supplying copies of the specifications and drawings for the associated patent applications designated as Docket 041-509-L; 041-510-L, 041-511-L, 041-512-L, 041-513-L, 041-514-L which involve the corresponding serial numbers, as shown below.

Docket 041-509-L: USSN 09/813,667

Docket 041-510-L: USSN 09/813,671

Docket 041-511-L: USSN 09/813,672

Docket 041-512-L: USSN 09/813,670

Docket 041-513-L USSN 09/813,668

Docket 041-514-L: USSN 09/813,669

Now attached hereto will be a brief summary of each one of these co-related pending patents.

BRIEF SUMMARY OF RELEVANT CO-PENDING CASES:

USSN 09/813,667 (Docket 041-509-L entitled "Thin Client Sizing Tool For Enterprise Server Farm Solution Configurator"):

This disclosure relates to methods of gathering information regarding a customer's requirements, and then using developed methods for configuring the size, the type of servers, the memory facilities required which will optimize a Server Farm design configuration for the particular situation of a given customer or user.

USSN 09/813,671 (Docket 041-510-L entitled "Configuration Interview Session Method For Thin Client Sizing Tool"):

This disclosure involves a method of communicating with a customer and recording the information on Window screens in order to ascertain the customer's requirements for the types of applications to be used and the numbers of users involved in order to develop a customer profile which can be stored in a database.

USSN 09/813,672 (Docket 041-511-L entitled "Metafarm Sizer Configuration Optimization Method For Thin Client Sizing Tool"):

This disclosure involves a sizing tool which will enable recommendations to be made for subdividing extremely large groups of users into numbers of Server Farms which constitute a Metafarm in order to provide Server Farm configuration optimization in a thin client sizing tool.

USSN 09/813,670 (Docket 041-512-L entitled "Solution Generation Method For Thin Client Sizing Tool"):

This disclosure describes a method for generating a configuration solution suitable for a thin client sizing tool, such that after a customer's profile information is developed, this method provides a way for calculating a base solution showing the appropriate number of servers, the proper disk space necessary, and the memory requirements involved for a Server Farm.

USSN 09/813,668 (Docket 041-513-L entitled "Method For Calculating User Weights For Thin Client Sizing Tool"):

This disclosure involves a method for calculating user weights for use during the solution generation and configuration process for an enterprise which uses a thin client sizing tool to propose an optimal configuration of Server Farm.

USSN 09/813,669 (Docket 041-514-L entitled "Method For Calculating Memory Requirements For Thin Client Sizing Tool"):

This is a method for generating the memory requirements suitable for a Thin Client Sizing Tool. Each user-type and each application in the Server Farm network is analyzed in order to develop the overall memory requirements for the Server Farm system which has been configured for a particular client-user.